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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,396	03/19/2001	Peter Holscher	SCH 1706	2405

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EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 07/17/2002

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/287,398

Applicant(s) Peter Holscher and

Examiner CTM Ford

Group Art Unit 1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on May 20, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, and 6 is/are pending in the application.
- Of the above claim(s) 11-15 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 6-9 and 16-18 is/are rejected.
- ☒ Claim(s) 10 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

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Applicants response of May 20, 2002 is noted.

The claims in the application are claims 1, 6--10, 11--15 and 16--18.

Claims 11--15 stand withdrawn, as being directed to non-elected subject matter.

Claim 1 is rejected under 35 U.S.C. 112, 2nd paragraph. Note in Q and U 5 or 6 membered heteroaryl with 1--3, N, O or S is the type of expression held unclear in *In re Wiggins* 179 USPQ 421 (1973) See the last Office Action.

What is anellated? Benzene fused anywhere? Support?

The approach in claim 16 is acceptable, if claim 16 were combined with claim 1.

The heterocyclic expressions in R8, B, R7 and A are rejected, as they employ the word "contains" when listing the hetero member. Contains is an open term. Open to the inclusion of any unknown.

Claim 1 is rejected under 35 U.S.C. 112, 1st paragraph, as the specification is inadequate to support the breadth of the claims sought. See the last Office Action.

What is the purpose of the proviso at the end of claim 1. See new 37 CFR 1.105.

R11 in claim 1 is rejected in regard to the 5 or 6 membered heteroaryl with 1 to 4, N, S or O, as noted in the rejection of Q and U, above.

R15 and R16 is rejected in claim 1, because of the open nature of "contains"; rejected above.

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Claim 6 is rejected under 35 U.S.C. 112, 2nd paragraph. It is not clear what ring is being formed from R1 and R2 together. Is this a saturated ring. Is it made up only of carbons in the ring? What is the point of attachment of: - (CHR9)r-NR7-A-N-R8-B.

There is no antecedent basis in claim 1 for claim 6. Claim 6 is rejected under 35 U.S.C. 112, 4th paragraph, as being an improper dependent claim.

Claim 1 and claim 6 are under 35 U.S.C. 112, 2nd paragraph. Applicants are entitled to be their own lexicographer up to the point that they assign a meaning to a letter or a term that already has a recognized IUPAC meaning: In re Hill, 73 USPQ 482. B means Boron.

Claims 6, 7, 8, 9, and 16--18 are rejected as being dependent on a rejected claim.

Claim 10 is objected to as being dependent on a rejected claim.

In regard to the heterocyclic phrases in claim 1: 5 or 6 member heteroaryl with 1--3, N, O or S, which is optionally anellated with benzene. Is that ortho fused benzene? Is that ortho fused any where on the unknown heterocyclic ring.² An unknown is made further indefinite with unknown fusion of another ring.

The word "contains" in claim 1 in R8 and B; R7 and A opens the claim to unknown, further, hetero atoms, including B, P or As.

The claims measure the invention; United Carbon Co. v. Binney & Smith Co. 55 U.S.P.Q. 381 at 384, col. 1, end of paragraph, Supreme Court of the United States (1942).

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The U.S. Court of Claims held to this standard in *Lockhead Aircraft Corp. V. United States*, 193 U.S.P.Q. 449, "Claims measure invention and resolution of invention must be based on what is claimed.

What is a heterocyclic member is defined variously. The USPTO classification definitions only recognizes C,O,S,N,Se, and Te as possible members of a possible heterocyclic ring.

The heteroaryl term, claimed in claim 1, are heterocyclic rings that require specific conception by the reader. Specific, producible, heterocyclic rings are not set forth in the claims. The sources of the starting materials, for the combinations claimed, is not set forth in the specification.

Exactly what ring is being claimed must be set forth in the claim.

Conception of what ~~the~~ intended heterocyclic ring, may be, should not be left to the reader.

Where is, what is intended by applicant, supported in the specification with sufficient representative exemplification. Note *United Carbon Co. v. Binney Smith Co.* 55 U.S.P.Q. 381, Supreme Court of the United States (1942) "an invention must be capable of accurate definition, and it must be accurately defined to be patentable", above at 386.

Assuming that applicants are claiming what they regard as the invention, there is in reality only two basic grounds for rejecting claims under 35 U.S.C. 112; first is that language *noted* is not precise enough to provide a clear-cut indication of the scope of the subject matter embraced by the claim, this ground finds its basis in second paragraph of section 112; second is

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that language is so broad that it causes the claim to have a potential scope of protection beyond that which is justified by the specification disclosure; this ground stems from first paragraph of section 112, merits of the language in claim must be tested in light of these two requirements.

The heteroaromatic variable is not precise and definite enough to provide a clear-cut indication of the scope of the subject matter embraced by the claim. The heteroaryl concept is so broad that ^{it} causes the claim to have a potential scope of protection beyond that which is justified by the specification disclosure.

The written description is considered inadequate here in the specification. Conception should not be the role of the reader. *The*

disclosure should not be merely an invitation to experiment. This is 35 U.S.C. 112, first and second paragraph ^{rejection}. If you (the public) find that it works, I claim it, is not a proper basis for patentability. In re Kirk, 153 U.S.P.Q. 49 at page 53.

The heterocyclic rings possible here is wide open to staggering possibilities.

Applicants place too much conception with the reader. Azines, Diazines, Triazines, Thiazine? Where are the starting materials in the specification?

One needs to know exactly where, in the ring, the hetero atoms are: 1,2 or 1,3 or 1,4 or 1,2,4 or 1,3,5, etc., as each is different entity with a separate classification and search.

These claims define the allowed invention, one must clearly know what is being claimed.

One, on reading the indication of heteroaryl applied by applicant in claim 1 - has no idea where the hetero atoms are in this unknown ring.

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Adjacent S or O atoms in a ring have not been shown to be producible, as stable, at room temperature. What is the source of the starting material? Where is the adequate representative exemplification in the specification to support the claim language?

The heteroaryl presents a problem of lack of clear claiming and support in the specification for the variables sought.

What exactly is intended, and where is that supported by the specification? Even any combination of 1--3 hetero atoms, selected from the group consisting of O, S, or N, rests specific conception with the reader. Not a fair burden in return for applicants receiving a 17/20 monopoly.

A Markush listing of intended, conceived of, producible heterocyclic rings is what is needed here. It is not possible to classify and search the molecule unless one knows exactly which heterocyclic ring is being claimed.

What the heterocyclic ring, is, is not expressed in the claim. The claim language sets forth the metes and bounds of the claim. Here the claim language is not specific enough to determine what is being claimed. The specification does not provide adequate representative exemplification to support the unlimited breadth of the terms claimed. Applicants rest specific conception with the reader.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

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The prior German application and the English translation are received and taken to remove WO/98/50372 as a reference here.

John M. Ford:jmr

July 16, 2002

A large, stylized handwritten signature in black ink, appearing to read "J.M. Ford".

JOHN M. FORD
PRIMARY EXAMINER

Grouped Unit 1624